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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,247	12/06/2001	Juergen A. Kortenbach	SYN-064B	5785

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,247

Applicant(s)

KORTENBACH ET AL.

Examiner

Bradford C Pantuck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 25-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-15, 23 and 33-36 is/are rejected.
- 7) ☒ Claim(s) 5, 12, 16-22, 24, 37, 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/06/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4, 6, 7, 8-11, 13-15, 23, and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,707,392 to Kortenbach. Regarding Claims 1, 2, 8, 10, Kortenbach discloses a forceps capable of applying clips, having a hollow member (15), a clevis (34) coupled to the distal end of the hollow member, and forceps jaws (36, 38) rotatably coupled to the clevis [Column 1, lines 52-55; Figures 2 and 10]. Each jaw [see Fig. 7] has a longitudinal extent. A longitudinal extent is considered to be something that extends longitudinally, which is considered to encompass a broad range of things. Each jaw has a channel (55), which extends along the longitudinal axis of the jaw. This channel (55) is most certainly capable of applying a surgical clip.

Prior art Figure 2 shows a device, with which Kortenbach's invention is meant to be used. Figure 2 shows push/pull wires (18, 19) coupled to the jaws, and it is evident that there is an actuation means at the proximal ends of these wires so that the user could actuate them [Column 1, lines 61-65]. Each jaw (51) has teeth capable of puncturing tissue, as shown in Figure 7.

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2. Regarding Claims 3, 4, 6, 7, 11, and 13, each channel is cup shaped [Column 4, lines 7-11] and will therefore be hook shaped at the distal end of channel (55) and will be able to provide the function of an anvil were a clip to be inserted therein.
3. Regarding Claim 9 and 14, at some point in the curved cup part of jaw (51), the angle will be 22 degrees relative to the vertical axis.
4. Regarding Claims 15, 23, 33-36, Kortenbach's forceps/the prior art that he shows in Figure 2 has a linkage (36b) coupled to a pull wire and coupled to the clevis [Column 1, lines 58-61] and a second element (38b) coupled (i.e. attached) to the first end effector (36a) for increasing the mechanical advantage of the effector closure. That is pulling on wire (18) will give mechanical advantage to the assembly, causing the jaws to close together with more force than if the jaws didn't have proximal tangs (38d, 36d). Applicant should note that "linkage" is a broad term, which does not necessarily refer to a linear series of connected members, as in Applicant's invention. Note: Examiner is considering each jaw (36) to have two different components separated by pin (40): distal to the pin is what Examiner is calling the "jaw" (36a, 38a) and proximal to the pin (40) is a linkage element (36b, 38b).

Allowable Subject Matter

5. Claims 5, 12, 16-22, 24, 37, 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,129,683 to Sutton et al.

Response to Arguments

7. Applicant's arguments, see Amendment, filed April 6, 2004, with respect to the rejection under U.S. Patent No. 5,354,312 to Brinkerhoff have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 5,707,392 to Kortenbach.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaver or McDermott can be reached on (703) 308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP
BCP

June 24, 2004

David O. Reip
DAVID O. REIP
PRIMARY EXAMINER